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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/958,088	10/27/1997	JOHN S. HENDRICKS	5062	2949

7590 01/29/2003

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/958,088	HENDRICKS ET AL. <i>PD</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Christopher Grant	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 August 2002 and 21 November 2002.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 28-73 is/are pending in the application.
- 4a) Of the above claim(s) 28-30,32-56 and 60-64 is/are withdrawn from consideration.
- 5) Claim(s) 31,47-49 and 67-79 is/are allowed.
- 6) Claim(s) 57-59,65 and 66 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Disposition of Claims

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14</u> . | 6) <input type="checkbox"/> Other: _____.                                   |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 57-59 and 65-66 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

The current invention is a system for cherry-picking desired digital programs or channels from one or more multiplexed signals comprising, a CPU that manages, monitors and ensures that programs are selected and sends instructions, a digital logic for selecting programs in accordance with instructions from the CPU and serializer for combining selected programs.

The specification fails to support the "CPU managing and monitoring the digital logic component and the serializer" now recited in claim 57 (last line).

The specification, at page 31, lines 7-10, describes that "*In addition to providing instructions to the combiner 104 for selection of videos, the control CPU (90) effectuates the combining process and monitors the process to ensure the integrity of the combined signal*"

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and, at page 30, lines 29-30, describes that “*The control CPU 90 also sends control signals to the digital logic 146*”.

The specification does not recite that the CPU manages and monitors the serializer as now recited in the claim.

Figures 7, 8, 9a, 9b and 12 do not show any connection from CPU (90) to the serializer (148) as indicated in the claim.

***Election Claim Status***

3. Claims 31, 47-49, 57-59 and 65-79 have been considered on the merits.
4. Claims 28-30, 32-56 and 60-64 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Allowable Subject Matter***

5. Claims 31, 47-49 and 67-79 are allowed.

***Response to Arguments***

6. Applicant's arguments filed 8/15/2002 have been fully considered.

**Response to Applicant's arguments**

- a) Applicant argues “..without undue experimentation” on page 4, (second paragraph) of the amendment filed 08/15/2002.

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In response, the Examiner posits that the disclosure fails to support the "CPU managing and monitoring the digital logic component and the serializer" now recited in claim 57 (last line).

b) Applicant argues the meaning of "managing" and "monitoring" and cites the New Oxford American Dictionary, Oxford Press (2001) on page 4 (third paragraph) of the amendment filed 08/15/2002.

In response, the Examiner will remind Applicant that the application filing date is October 27, 1997 and it has continuity to earlier filing date(s). It is improper for Applicant to cite a Dictionary published in the year 2001 as evidence for terms utilized in an application filed prior to the year 2001.

c) Applicant argues that "...the specification at page 31, lines 7-10, states "[i]n addition to providing instructions to the combiner 104..." (on page 4 (last paragraph) of the amendment) and that "As recite elsewhere in the specification, in the embodiment at issue, the serializer does the combining and, therefore, the combining process and produces the combined signal. The serializer 148 performs the final step of the combiner 104, combining the signal. Page 40, liens 23-24" on page 4, (last line) - page 5, line 2 of the amendment.

In response, the Examiner agrees in-part with the Applicant. The Examiner posits that the CPU manages the combining process. However, the combiner (shown fully in figure 8) comprises

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numerous elements including but not limited to fifos (156), output gates (158) and serializer (148). Therefore, it is true that the CPU manages the combining process. However, Applicant admits that the serializer is the final stage in the combining process. The disclosure (specification and drawings) does not support the CPU managing the serializer. Again, Applicant acknowledges the fact that the serializer is the final component in the combiner and a feedback or connection is not made from the serializer to the CPU (page 5, lines 8-9 of the amendment filed 8/15/2002). Therefore, Applicant's arguments are not persuasive.

d) Applicant's arguments with respect to claims 47-49 on page 3 of the amendment are persuasive.

### *Conclusion*

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306 0377.

  
**Christopher Grant**  
**Primary Examiner**  
**January 26, 2003**